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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,191	11/21/2001	Stephen J. Padden	HM-69621	4104

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EXAMINER
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TRUONG, THANH K

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/015,191

Applicant(s)

PADDEN, STEPHEN J.

Examiner

Thanh K. Truong

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-11, 21 and 25-27 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-6, 8-11, 21 and 25-27 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All    b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This action is in response to applicant's amendment received on December 16, 2005.
2. Applicant's cancellation of claims 7, 12-20, 22-24, 28 and 29 is acknowledged.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 21 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolfe (4,014,493).

Wolfe discloses (figures 12 & 13) an apparatus comprising:

a housing (22, 41) having a periphery that includes a bottom wall and a first side wall; a recess that extends into the bottom wall and forms a base opening in the bottom wall (the recess to accommodate the stapler);

the recess extending into the first sidewall and forms a wall opening in the first sidewall;

a stapler (the portion that fits into the recess of the housing) comprising a hinged end from which extend a stapler base and an activating member and a stapler open end (slot 24) for receiving materials to be stapled, wherein the stapler base extends into the base opening and forms a portion of the bottom wall and the actuating member is

releasably secured to the housing in a manner to position the stapler open end at the wall opening (figures 12 & 13).

Wolfe further discloses (figures 12 & 13): the housing side wall opening and bottom wall opening comprise a recess in the housing peripheral walls and the stapler is fitted into the recess; the peripheral walls include a bottom wall into which extends the bottom wall opening and side wall into which extends the side wall opening, the base of the stapler being about coplanar with the bottom wall; the open end of the stapler is proximate to the side wall; the stapler has an outline and the peripheral walls include a corner with a recess having a shape that corresponds to the outline; and the stapler being fitted into the recess.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-6, 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe (4,014,493) in view of Padden (6,009,584).

As discussed above in paragraph 4 of this office action, Wolfe discloses the claimed invention, but does not expressly disclose the recess for the stapler as recited in claims 2-6 and 8, however, it is well known in the art to create recess in the housing of the multiple-purpose tool holder in such a way that the recess accommodates the

shape and size of the tool being inset to the housing. The recess comprises slot, curve portion, flange, tab, etc.

Padden's disclosure supports the contention that it is well known in the art to create recess in the housing of the multiple purpose tool holder with varieties of shapes and sizes to accommodate varieties of tool. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have combined Wolfe and Padden, and modified Wolfe by incorporating the creation of recesses in the housing of the multiple-purpose tool holder to fit different tools as taught by Padden.

As for a hole punch to fit an opening at the corner opening in the tool housing as recited in the claims 9 and 10, the examiner takes official notice that it is within the skill of one in the art to provide a hole puncher in the multiple purpose tool holder providing a complete stationery tool set.

Regarding to claim 9, the applicant has not challenged the examiner's taking the Official Notice (Office action dated December 15, 2004). Therefore, the examiner's position (regarding the rejection of claim 9) is maintained and the subject matter, per se, of claim 9 is deemed admitted prior art.

7. Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe (4,014,493) in view of Ng (6,145,994).

As discussed above in paragraph 4 of this office action, Wolfe discloses the claimed invention, but does not expressly disclose a lighting means mounted within the

housing and oriented for illumination through the aperture, and an activation means to illuminate the lighting.

Ng discloses an apparatus comprising lighting means (30) mounted within the aperture and an activation means (28) to illuminate the lighting, Ng apparatus provides the multiple-purpose tool holder with lighting capability. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Wolfe by incorporating the lighting apparatus as taught by Ng providing the multiple-purpose tool holder with lighting capability.

### ***Response to Arguments***

8. Applicant's arguments filed December 16, 2005 have been fully considered but they are not persuasive.

9. In response to the Applicant's argument that: "It is clear that significant imagination and hindsight is being used by the Examiner to somehow construe that a two-layered solid bottom anticipates Applicant's claims", the examiner respectfully disagrees for the following reasons:

Firstly, there is no hindsight involve in the rejection of claims under 102 rejection, because the reference (Wolfe '493) clearly anticipates the claimed invention.

Secondly, there is little imagination required to construe the claims, because the claims (1, 21 and 27) are so broadly claimed such that the reference is clearly anticipated (read) the claims.

Wolfe '493 (Figs 12-13) clearly shows that:

a). “a recess that extends into said bottom wall and forms a base opening in said bottom wall” and “recess extends into said first sidewall” as recited in claim 1; the recess including the opening (23) that extends into the bottom wall, and the recess that accommodates the stapler (2) – the recess that extends into the housing (22, 41);

b). “wherein said stapler base extends into said base opening and forms a portion of said bottom wall” as recited in claim 1; the base of the stapler (2) clearly extends into the base opening (23) and forms a portion of the bottom wall – the base of the stapler (2) may be lay on top of the other layers, but it is a portion of the bottom wall nevertheless. The fact that Wolfe '493 discloses additional structure not claimed is irrelevant.

10. In response to the Applicant's argument that: “it is unclear with respect to what the Examiner intends on being the claimed housing periphery”, the examiner construes the word “perimeter” strictly base on the definition below:

1. *A line that forms the boundary of an area; a perimeter. See synonyms at circumference.*
2. *The surface of a solid.*
3.
  - a. *The outermost part or region within a precise boundary.*
  - b. *A zone constituting an imprecise boundary.*

The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2004, 2000 by Houghton Mifflin Company.

Claim 1, recites “a housing having a periphery that includes a bottom wall and a first side wall”, and Figs 12 and 13 of Wolfe '493 clearly show that. The periphery of the Wolfe '493 reference may not be straight as the disclosure of the present application,

however, Wolfe '493 discloses a housing (22, 41) having a periphery that includes a bottom wall and a first side wall as claimed.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

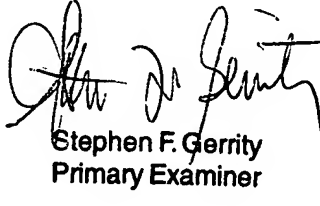
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tkf  
February 10, 2006.



Stephen F. Gerrity  
Primary Examiner